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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,407	12/12/2003	Joanne Elizabeth Burn	021565-122	4358
21839	7590	10/31/2006		
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
			EXAMINER BAGGOT, BRENDAN O	
			ART UNIT 1638	PAPER NUMBER

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/733,407	Applicant(s) BURN ET AL.	
	Examiner Brendan O. Baggot	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 25-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Restriction / Election***

1. The Office acknowledges the receipt of Applicant's restriction election, filed 8/28/06. Applicant elects Group III, claims 17-24, with traverse stating primarily that the scopes of the inventions overlap and the searches would overlap. Applicant's traversal is unpersuasive for the following reasons: While a search of the prior art for one group may overlap with that of another group, they are not co-extensive of each other and thus would represent undue burden on Office resources. Claims 1-16, 25-39 are nonelected. Claims 17-24 are pending and examined in the instant application.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

This restriction is made FINAL.

### ***Sequence Listing***

2. Applicant's computer readable format sequence listing has been entered.

### ***Drawings***

3. The Office may:

... object to and require corrected drawings within a set time period, if the drawings.

..

(A) have ... text that is illegible ... See 37 CFR 1.84(l) and (p)(1).

M.P.E.P. § 507.

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The alignments in the Figures have text that is illegible because it is too small and is a copy of a copy. New drawings which are legible and which do not add new matter should be submitted. In the interest of compact prosecution and as a courtesy to Applicant, the application has been examined on the merits. Appropriate correction is required in response to this Office Action.

### ***Claim Objections***

4. Claim 18 is objected to because of the following informalities: the claim reads on non-elected subject matter. Appropriate correction is required.

### **Claim Rejections - 35 U.S.C. §112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 17-24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

In Claim 17, the recitation of "variant" is indefinite. It is unclear how the sequence is varied: is the sequence biotinylated/radiolabelled, substituted with T-DNA tags, or missing the active site amino acids. Does the Applicant mean functional, inheritable fragment? All dependent claims not correcting the indefiniteness of Claim 17 are similarly rejected.

***Claim Rejections - 35 U.S.C. §101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed inventions encompass untransformed plants and seeds, which are a product of nature and not one of the five classes of patentable subject matter. Claim 24 is drawn to parts such as seeds and progeny of the transformed plant. Due to Mendelian inheritance of genes, a single gene introduced into a parent plant would only be transferred at most to half the male gametes and half the female gametes. This translates into only three fourths of the progeny having at least a single copy of the transgene and one quarter of the progeny without a copy of the transgene. Since the claim encompasses progeny that lack the transgene, the claim encompasses plants and seeds that are indistinguishable from plants and seeds that would occur in nature. See *American Wood v. Fiber Disintegrating Co.*, 90 U.S. 566 (1874), *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1 (1931), *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948), *Diamond v. Chakrabarty*, 206 USPQ 193 (1980).

7. No Claim is allowed. SEQ ID NO: 2 encoding SEQ ID NO: 6 or isolated sequences 95% identical thereto are deemed free of the prior art in light of the failure of

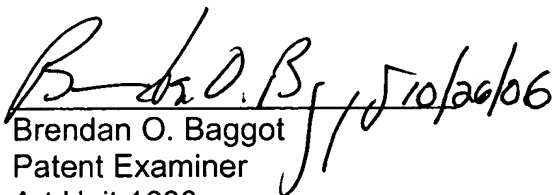
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the prior art to teach or reasonably suggest SEQ ID NO: 2 encoding SEQ ID NO: 6 operably linked to a promoter and 3' UTR in a chimeric gene.

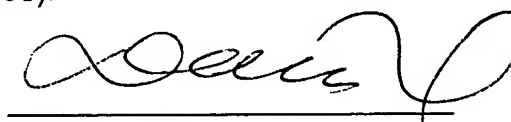
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brendan O. Baggot whose telephone number is 571/272-5265. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571/272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brendan O. Baggot  
Patent Examiner  
Art Unit 1638



David T. Fox  
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bob